

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Yoshio Yamauchi et al.	:	
	:	Confirmation No.: 9818
Serial No.: 10/583286	:	
	:	Group Art Unit:
Filing Date: 16 June 2006	:	
	:	Atty. Docket: IWI-16646
For: METHOD FOR ANALYZING PROTEINS	:	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**RESPONSE TO NOTIFICATION OF ABANDONMENT AND REQUEST TO
WITHDRAW THE HOLDING OF ABANDONMENT**

Sir:

This paper is responsive to the Notification of Abandonment mailed December 28, 2007 in the above noted application.

As undersigned counsel discussed with Examiner Alvarado on January 7, 2008, a response was timely filed to the Office Communication mailed August 7, 2007. Such Communication provided a 2 month response period that was extendable under 37 CFR 1.136.

Specifically, a response was filed on December 28, 2008 (copy attached) and it included a Petition for a three month extension of time to reply to the Office Communication mailed August 7, 2007 which had a response deadline that was extendable under 37 CFR 1.136(a). With the Petition for extension of time the response deadline extended until January 7, 2008 (a total of 5 months from August 7, 2007).

In light of the foregoing, undersigned counsel requests that the Office withdraw that Notification of Abandonment and issue a notice to such effect. Please do not hesitate to contact undersigned counsel if there are any questions.

Respectfully submitted,

RANKIN, HILL & CLARK LLP



Kenneth A. Clark
Reg. No. 32,119

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Under the paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a)

Docket Number (Optional) IWI-16646

In re Application of Yoshio Yamauchi et al.

Application Number 10/583286

Filed 6/16/2006

For Method For Analyzing Proteins

Art Unit

Examiner

This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above identified application.

The requested extension and appropriate non-small-entity fee are as follows (check time period desired):

- ☐ One month (37 CFR 1.17(a)(1)) \$ _____
- ☐ Two months (37 CFR 1.17(a)(2)) \$ _____
- ☒ Three months (37 CFR 1.17(a)(3)) \$ 1,050
- ☐ Four months (37 CFR 1.17(a)(4)) \$ _____
- ☐ Five months (37 CFR 1.17(a)(5)) \$ _____

- ☒ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee amount shown above is reduced by one-half, and the resulting fee is: \$ 525.

- ☐ A check in the amount of the fee is enclosed.

- ☐ Payment by credit card. Form PTO-2038 is attached.

- ☐ The Director has already been authorized to charge fees in this application to a Deposit Account.

- ☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 18-0160.

I have enclosed a duplicate copy of this sheet.

I am the ☐ applicant/inventor.

- ☐ assignee of record of the entire interest. See 37 CFR 3.71.
Statement under 37 CFR 3.73(b) is enclosed (Form PTO/SB/96).

- ☒ attorney or agent of record. Registration Number 32,119

- ☐ attorney or agent under 37 CFR 1.34(a).
Registration number if acting under 37 CFR 1.34(a) _____

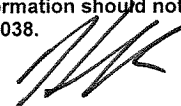
WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

December 28, 2007

Date

(216) 566-9700

Telephone Number


Signature

Kenneth A. Clark

Typed or printed name

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

- ☐ Total of _____ forms are submitted.

This collection of information is required by 37 CFR 1.136(a). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 6 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/583,286
Cnfrm. No. : 9818
Applicant(s) : Yoshio Yamauchi et al.
Filed : December 17, 2004
Title : METHOD FOR ANALYZING PROTEINS
TC/A.U. : none
Examiner : none
Docket No. : IWI-16646

Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION AND RESPONSE TO OFFICE
COMMUNICATION OF AUGUST 7, 2007

Sir:

In response to the Communication mailed August 7, 2007 and the Notification of Missing Requirements under 35 U.S.C. 371 mailed March 16, 2007, Applicants Petition the Commissioner under 37 C.F.R. 1.182 to accept the Declaration on file supplemented by the enclosed declaration under 37 C.F.R. § 1.67. The Notice states that the current Declaration does not comply with 37 C.F.R. 1.497(a) and (b) because it (1) fails to comply with either 37 C.F.R. 1.66 or 1.68, and (2) that the family name of the second inventor does not correspond with the name on the published application. The second inventor's name was mistranslated from the Japanese language to the English language in the PCT application, published as WO 2005/059538 A1. The second inventor's name is, in fact:

Takashi SHINKAWA.

As evidence of this, Applicants enclose copies of the following:

1. Declaration of the second inventor of the subject application, Takashi SHINKAWA, attesting to the fact that he is an inventor, and it was his name that was intended to be noted as the second inventor, rather than the mistranslated ARAWAKA.
2. Declaration of Patent Attorney Yuji Iwahashi, the Japanese Patent Attorney who handled the priority filing of the corresponding application in Japan as well as the PCT filing, that the second inventor of the subject application, Takashi SHINKAWA, is known to Mr. Iwahashi, and that Takashi SHINKAWA is an inventor of the subject application.
3. Copy of the front page of the corresponding Canadian Patent Application, CA2550017 (A1), showing the name of the second inventor as "SHINKAWA, TAKASHI."
4. Copy of front page of the corresponding Australian Patent Application, AU 2004300084 A1, showing the name of the second inventor as "SHINKAWA, TAKASHI."

Based on the evidence presented, Applicants respectfully petition the Commissioner to accept the declaration executed on June 6, 2006, as supported by the declarations filed herewith as sufficient to meet the requirements of 37 C.F.R. 1.497(a) and (b), as well as 37 C.F.R. 1.68, in establishing that the name of the second inventor is, in fact, Takashi SHINKAWA.

Because a petition fee of \$400 was paid in support of the previous petition in the above-captioned patent application, and the petition was dismissed, it is believed that the \$400 previously paid may be applied to the instant petition-response. If there are any additional fees resulting from this communication, please charge the same to our Deposit Account No. 18-0160, our Order No. IWI-16646.

Included herewith is also a petition for a three (3) month extension of time extending the response deadline in the Office Communication from October 7, 2007 until January 7, 2008.

Respectfully submitted,

RANKIN, HILL, PORTER & CLARK LLP



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Cleveland, Ohio 44115-1405
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Enclosures

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	10/583,286
Cnfrm. No.	:	9818
Applicant(s)	:	Yoshio Yamauchi et al.
Filed	:	June 16, 2006
Title	:	METHOD FOR ANALYZING PROTEINS
TC/A.U.	:	none
Examiner	:	none
Docket No.	:	IWI-16646

Mail Stop PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION UNDER 37 C.F.R. §1.67

Sir:

This Declaration under 37 C.F.R. §1.67 is submitted to establish that the family name of the second inventor of the subject application is in fact SHINKAWA. This Declaration is filed in partial response to the Communication mailed August 7, 2007.

1. This Declaration is made by Yuji IWAHASHI, the patent attorney who filed the priority Japanese and PCT patent applications corresponding to the above-captioned patent application.
2. The inventors of the subject matter embodied in the application are Yoshio YAMAUSHI, Takashi SHINKAWA, and Toshiaki ISOBE.
3. The undersigned declares that Takashi SHINKAWA is the second inventor of the subject application.

4. The undersigned declares that the family name of Takashi SHINKAWA was mistranslated as ARAKAWA in the English-language publication of the corresponding international application, PCT/JP04/18923 filed December 17, 2004.

5. The undersigned states that the characters used to express the family name of the second inventor in the Japanese language may be translated into English as "SHINKAWA" or "ARAKAWA," and without context, it is impossible to determine which is intended. The mistranslation of the name SHINKAWA was a mistake made without deceptive intent.

6. The family name of the second inventor was, in fact, mistranslated, and should be expressed in the English language as "SHINKAWA."

7. The undersigned hereby declares that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: December 17, 2007


Yuji IWAHASHI

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/583,286
Cnfrm. No. : 9818
Applicant(s) : Yoshio Yamauchi et al.
Filed : June 16, 2006
Title : METHOD FOR ANALYZING PROTEINS
TC/A.U. : none
Examiner : none
Docket No. : IWI-16646

Mail Stop PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION UNDER 37 C.F.R. §1.67

Sir:

This Declaration under 37 C.F.R. §1.67 is submitted to establish that the family name of the second inventor of the subject application is in fact SHINKAWA. This Declaration is filed in partial response to the Communication mailed August 7, 2007.

1. This Declaration is made by the second co-inventor, of the above-named pending patent application, namely: Takashi SHINKAWA.
2. The inventors of the subject matter embodied in the application are Yoshio YAMAUSHI, Takashi SHINKAWA, and Toshiaki ISOBE.
3. The undersigned, Takashi SHINKAWA, declares that his family name was mistranslated as ARAKAWA in the English-language publication of the corresponding international application, PCT/JP04/18923 filed December 17, 2004.

4. The undersigned states that the characters used to express the family name of the second inventor in the Japanese language may be translated into English as "SHINKAWA" or "ARAKAWA," and without context, it is impossible to determine which is intended. The mistranslation of the name SHINKAWA was a mistake made without deceptive intent.

5. The family name of the second inventor was, in fact, mistranslated, and should be expressed in the English language as "SHINKAWA."

6. The undersigned hereby declares that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: December 19, 2007

Takashi Shinkawa

Takashi SHINKAWA

(19)



Canadian
Intellectual Property
Office

An Agency of
Industry Canada

Office de la Propriété
Intellectuelle
du Canada

Un organisme
d'Industrie Canada

(11)

CA 2 550 017

(13)

A1

(40) 30.06.2005

(43) 30.06.2005

(12)

(21) 2 550 017

(22) 17.12.2004

(51) Int. Cl.:

C12Q 1/37 (2006.01)

G01N 27/62 (2006.01)

G01N 33/68 (2006.01)

(85) 16.06.2006

(86) PCT/JP04/018923

(87) WO05/059538

(30) 2003-419921 JP 17.12.2003

(71)

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(72)

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ISOBE, TOSHIAKI (JP).

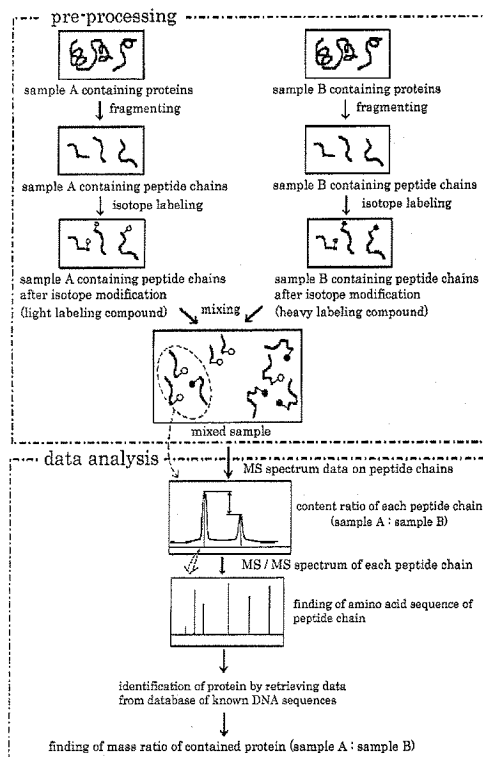
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GOWLING LAFLEUR HENDERSON LLP

(54) PROCEDE D'ANALYSE DE PROTEINES
(54) PROTEIN ANALYSIS METHOD

(57)

It is intended to provide a protein analysis method whereby proteins can be identified and the quantification data can be obtained by a convenient procedure. Namely, a protein analysis method characterized by comprising: the step of cleaving two protein-containing samples individually with restriction enzymes at specific amino acid sites to give peptide chain-containing samples; the step of modifying peptide chains contained in the peptide chain-containing samples with labeling compounds having different masses due to isotopes so as to impart different masses to the peptide chains; the step of mixing the isotope-labeled peptide chain-containing samples and fractionally quantifying the sample mixture for individual peptide chains so as to determine a content ratio; the step of selecting peptide chains to be subjected to amino acid sequence identification from the peptide chains and identifying the amino acid sequences of the peptide chains; the step of specifying proteins corresponding to the peptide chains; and the step of determining the content ratio of the thus specified proteins based on the fractional quantification data of the peptide chains.



(19) AUSTRALIAN PATENT OFFICE

(54) Title
Protein analysis method

(51)⁶ International Patent Classification(s)
G01N 33/68 (2006.01)20060101AFI2006040
G01N 33/68 8BMEP
PCT/JP2004/018923

(21) Application No: 2004300084

(22) Application Date: 2004.12.17

(87) WIPO No: WO05/059538

(30) Priority Data

(31) Number	(32) Date	(33) Country
2003-419921	2003.12.17	JP

(43) Publication Date : 2005.06.30

(71) Applicant(s)
Yoshio Yamauchi; Takashi Shinkawa; Toshiaki Isobe

(72) Inventor(s)
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(74) Agent/Attorney
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